

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

After amending the claims as set forth above, Claims 16-17, 20-28, 30-32 and 35-47 are now pending in this application.

Claim Objections

On page 2 of the Office Action, the Examiner objected to Claim 16 because it lacks a comma between “a translucent covering layer” and “wherein the covering layer” and objected to Claim 24 because the recitation of “the surface side of the optical conductor facing the interior” lacked antecedent basis. Claim 16 has been amended to include the comma. Regarding Claim 24, it is respectfully submitted that there is proper antecedent basis for “the side surface” provided in line 4 of Claim 24. For at least these reasons, favorable reconsideration of the objection is respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Rejection of Claims 16-17, 20-21, and 46

On page 3 of the Office Action, the Examiner rejected Claims 16-17, 20-21, and 46 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,652,128 titled “Backlighting method for an automotive trim panel” issued on November 25, 2003, to Misaras (“Misaras”).

The Examiner stated that:

Misaras discloses a lining element for a vehicle [Abstract] including...A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer is designed to be elastically compressible...Wherein the translucent covering layer includes an elastomer that has an at least partially foamed structure [Column 2, Line 65 - Column 3, Line 2]. (paragraph 7 of the Office Action).

Misaras is directed to a “backlighting method for an automotive trim panel” including a trim panel 100 having a cover layer 102, a cushion/foam layer 104, and a retainer layer 106. The cover layer 102 may be made of leather, vinyl (PVC), polyurethane, a textile such as cloth, or other pliable materials. (see Misaras at col. 2, line 66 to col. 3, line 2).

Claim 16 (as amended) is in independent form and recites a “lining element” including, in combination with other elements, “a translucent covering layer,” “wherein the translucent covering layer comprises a translucent elastomer that has an at least partially foamed structure.” Claims 17, 20-21, and 46 depend from independent Claim 16.

Misaras does not identically disclose a “lining element” wherein, among other elements, “the translucent covering layer comprises a translucent elastomer that has an at least partially foamed structure,” as recited in independent Claim 16. Indeed, Misaras discloses only a cushion/foam layer having a hole through which the light source 110 can extend. Claim 16 is patentable over Misaras.

Dependent Claims 17, 20-21, and 46, which depend from independent Claim 16, are also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 16-17, 20-21, and 46 under 35 U.S.C. § 102(e).

Rejection of Claims 22-23

On page 4 of the Office Action, the Examiner rejected Claims 22-23 under 35 U.S.C. § 102(e) as being anticipated by Misaras.

The Examiner stated that:

Misaras discloses a lining element for a vehicle [Abstract] including...A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer is designed to be elastically compressible...Wherein the translucent covering layer includes an elastomer that is at least one of ethylene propylene diene monomer, silicone and polyurethane [Column 2, Line 65 - Column 3, Line 2]...Wherein the elastomer having a hardness of 20 to 70 Shore A [Column 3, Lines 21-23]. (paragraph 16 of the Office Action).

Misaras is directed to a “backlighting method for an automotive trim panel” including a trim panel 100 having a cover layer 102, a cushion/foam layer 104, and a retainer layer 106 in which the cover layer 102 may be made of leather, vinyl (PVC), polyurethane, a textile such as cloth, or other pliable materials. (see Misaras at col. 2, line 66 to col. 3, line 2).

Claim 22 (as amended) is in independent form and recites a “lining element” including, in combination with other elements, “a translucent covering layer,” “wherein the

covering layer includes material that is both translucent and is elastically compressible.” Claim 23 depends from independent Claim 22.

Misarar does not identically disclose a “lining element” wherein, among other elements, “the covering layer includes material that is both translucent and is elastically compressible” as recited in independent Claim 22. Indeed, Misarar merely discloses a cushion/foam material that is not translucent. (see Misarar at Figs. 1-2). The rejection of Claim 22 over Misarar is improper. Claim 22 is patentable over Misarar.

Dependent Claim 23, which depends from independent Claim 22, is also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 22-23 under 35 U.S.C. § 102(e).

Rejection of Claims 24-25

On page 5 of the Office Action, the Examiner rejected Claims 24-25 under 35 U.S.C. § 102(e) as being anticipated by Misarar.

The Examiner stated that:

Misarar discloses a lining element for a vehicle [Abstract] including...A base part [Figures 1, 3: (314)]...A translucent covering layer [Figures 1, 3: (102, 104, 302)]...Wherein the base part is designed as a plate-like operator, which is operationally associated with a light generator [Figure 1: (110); Column 4, Lines 24-25]... (paragraph 16 of the Office Action).

Misarar is directed to a “backlighting method for an automotive trim panel” including a trim panel 100 having a cover layer 102, a cushion/foam layer 104, and a retainer layer 106 in which the cover layer 102 may be made of leather, vinyl (PVC), polyurethane, a textile such as cloth, or other pliable materials. (see Misarar at col. 2, line 66 to col. 3, line 2).

Claim 24 (as amended) is in independent form and recites a “lining element” including, in combination with other elements, “a translucent covering layer,” “wherein the covering layer includes material that is both translucent and is elastically compressible.” Claim 25 depends from independent Claim 24.

Misarar does not identically disclose a “lining element” wherein, among other elements, “the covering layer includes material that is both translucent and is elastically compressible” as recited in independent Claim 24. Indeed, Misarar merely discloses a

cushion/foam material that is not translucent. (see Misarar at Figs. 1-2). The rejection of Claim 24 over Misarar is improper. Claim 24 is patentable over Misarar.

Dependent Claim 25, which depends from independent Claim 24, is also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 24-25 under 35 U.S.C. § 102(e).

Rejection of Claim 44

On page 6 of the Office Action, the Examiner rejected Claim 44 under 35 U.S.C. § 102(e) as being anticipated by Misarar.

The Examiner stated that:

Misarar discloses a lining element for a vehicle [Abstract] including...A base part [Figures 1, 3: (314)]...A covering layer [Figures 1, 3: (102, 104, 302)]... (paragraph 18 of the Office Action).

Misarar is directed to a “backlighting method for an automotive trim panel” including a trim panel 100 having a cover layer 102, a cushion/foam layer 104, and a retainer layer 106 in which the cover layer 102 may be made of leather, vinyl (PVC), polyurethane, a textile such as cloth, or other pliable materials. (see Misarar at col. 2, line 66 to col. 3, line 2).

Claim 44 (as amended) is in independent form and recites a “lining element” including, in combination with other elements, “a base part,” “wherein the base part is a generally plate-like optical conductor” and “wherein the optical conductor is configured to conduct light to the covering layer such that light exits from the surface side and to the interior of the vehicle.”

Misarar does not identically disclose a “lining element” wherein, among other elements, “the optical conductor is configured to conduct light to the covering layer such that light exits from the surface side and to the interior of the vehicle” as recited in independent Claim 44. Indeed, Misarar merely discloses that the light travels through the cover layer 302 (which the PTO considers to be the covering layer of Claim 44) then through a translucent layer 314 (which the PTO considered to be base part of Claim 44), which is a different order from that specified in Claim 44. (see Misarar at Fig. 3A). The rejection of Claim 44 over Misarar is improper. Claim 44 is patentable over Misarar.

The Applicant respectfully requests withdrawal of the rejection of Claim 44 under 35 U.S.C. § 102(e).

Claim Rejections – 35 U.S.C. § 103(a)

Rejection of Claims 22-23

On page 7 of the Office Action, the Examiner rejected Claims 22-23 under 35 U.S.C. § 103(a) as being obvious over Misaras in view of U.S. Patent No. 6,227,689 titled “Illumination device for exterior mirror” to Miller (“Miller”).

The Examiner stated that:

Misaras discloses a lining element for a vehicle [Abstract] including...A translucent covering layer [Figure 1: (102, 104)], wherein the covering layer is designed to be elastically compressible...Wherein the translucent covering layer includes an elastomer that is at least one of ethylene propylene diene monomer, silicone and polyurethane [Column 2, Line 65 - Column 3, Line 2]. (paragraph 21 of the Office Action).

However, the Examiner acknowledged that Misaras does not disclose an elastomer having a hardness of 20 to 70 Shore A.

The Examiner stated that Miller discloses:

“Preferably, body 16 of bulb holder 10 is injection molded with at least two stampings 46. Body 16 may be molded from a flexible polymeric material, preferably having a Shore A durometer hardness of between approximately 50 Shore A and 105 Shore A, more preferably between approximately 60 Shore A and 90 Shore A, and most preferably approximately 60 Shore A, such as a thermoplastic elastomer (TPE) material, such as Kraton G7720B or the like. Alternatively, a plasticized poly vinyl chloride (PVC) material, a flexible urethane, a silicone or the like may be used, without affecting the scope of the present invention. By injection molding of body 16 with the stampings within the flexible material, the present invention assures a water-tight construction to substantially preclude water from entering the terminals 20 and 24 within body 16” [Column 5, Lines 29-44]. (paragraph 22 of the Office Action).

The Examiner concluded that:

It would have been obvious...to modify the lining element of Misaras, specifically the elastomer, to incorporate the Shore durability characteristics, as principally taught by Miller, so as to ensure appropriate hardness and flexibility of the elastomer. It has also been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. (paragraph 22 of the Office Action).

Misaras is directed to a backlighting method for an automotive trim vehicle.

Miller is directed to an illumination device for exterior mirror.

Claim 22 (as amended) is in independent form and recites a “lining element” including, in combination with other elements, “a translucent covering layer,” “wherein the covering layer includes material that is both translucent and is elastically compressible.” Claim 23 depends from independent Claim 22.

The “lining element” recited in independent Claim 22 (as amended) would not have been obvious in view of Misaras, alone or in any proper combination with Miller, under 35 U.S.C. § 103(a). Misaras, alone or in any proper combination with Miller, does not disclose, teach or suggest a “lining element” wherein, in combination with other elements, “the covering layer includes material that is both translucent and is elastically compressible.” To transform the backlighting method of Misaras and the illumination device of Miller into a “lining element” (as recited in Claim 22) would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

The lining element recited in independent Claim 22, considered as a whole, would not have been obvious in view of Misaras and/or Miller. The rejection of Claim 22 over Misaras in view of Miller under 35 U.S.C. § 103(a) is improper. Therefore, Claim 22 is patentable over Misaras in view of Miller.

Dependent Claim 23, which depends from independent Claim 22, is also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 22-23 under 35 U.S.C. § 103(a).

Rejection of Claims 26-28

On page 9 of the Office Action, the Examiner rejected Claims 26-28 under 35 U.S.C. § 103(a) as being unpatentable over Misaras. Claims 26-28 depend from Claims 24-25.

As previously mentioned, Misaras does not identically disclose a “lining element” including, among other elements, “a translucent covering layer,” “wherein the covering layer includes material that is both translucent and is elastically compressible” as recited in independent Claim 24. Indeed, Misaras merely discloses a cushion/foam material that is not

translucent. (see Misarar at Figs. 1-2). The rejection of Claim 24 over Misarar is improper. Claim 24 is patentable over Misarar.

Dependent Claims 26-28, which depend from independent Claim 24, are also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 26-28 under 35 U.S.C. § 103(a).

Rejection of Claim 30

On page 9 of the Office Action, the Examiner rejected Claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Misarar. Claim 30 depends from Claim 16.

As previously mentioned, Misarar does not identically disclose a “lining element” including, among other elements, “a translucent covering layer,” “wherein the translucent covering layer comprises a translucent elastomer that has an at least partially foamed structure” as recited in independent Claim 16. Indeed, Misarar discloses only a cushion/foam layer that has holes, which means that the foam layer is not a translucent elastomer. The rejection of Claim 16 over Misarar is improper. Claim 16 is patentable over Misarar.

Dependent Claim 30, which depends from independent Claim 16, is also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claim 30 under 35 U.S.C. § 103(a).

Rejection of Claims 31-32, 35-36, 38-43, 45, and 47

On page 10 of the Office Action, the Examiner rejected Claims 31-32, 35-36, 38-43, 45, and 47 under 35 U.S.C. § 103(a) as being upatentable over Misarar.

The Examiner stated that:

Misarar discloses a lining element for a vehicle [Abstract] including...A base part [Figure 1: (108, 110)]..A surface side facing the interior of the vehicle and suitable for emitting light [Figure 1: proximate (102)]..At least one mirror surface distributed in the lining element to reflect light therefrom [Figure 1: (108); Column 3, Lines 51-53]...A covering layer [Figure 1: (102, 104, 106)]. (paragraph 26 of the Office Action).

However, the Examiner acknowledged that Misarar does not disclose a translucent covering layer having an optical transmissivity in the visible spectral range of 5 to 10%. (paragraph 26 of the Office Action).

The Examiner concluded that:

However, it would have been obvious to...incorporate the translucent covering layer to have an optical transmissivity in the visible spectral range of 5 to 10%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. In this case, one would want to provide the translucent covering layer with an optical transmissivity for its intended purpose, such as a non-overbearing illumination. (paragraph 26 of the Office Action).

Misarar is directed to backlighting method for an automotive trim vehicle.

Claim 31 is in independent form and recites a “lining element” including, in combination with other elements, “a covering layer,” “wherein the covering layer is translucent, and wherein the translucent covering layer has an optical transmissivity in a visible spectral range of 5 to 10%.” Claims 32, 35-36, 38-43, 45, and 47 depend from independent Claim 31.

The “lining element” recited in independent Claim 31 would not have been obvious in view of Misarar. Misarar does not disclose, teach or suggest a “lining element” wherein, in combination with other elements, “the translucent covering layer has an optical transmissivity in a visible spectral range of 5 to 10%.” To transform the backlighting method of Misarar into a “lining element” (as recited in Claim 31) would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

It is asserted that, in relation the optical transmissivity of the translucent covering layer, where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (paragraph 26 of the Office Action). This position is clearly contrary to the case law and MPEP 2144.05, which states: “[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).” In this case, the PTO has not pointed to any prior art to support the proposition that the optical transmissivity of the translucent covering layer is a result-effective variable that would require any kind of optimization. Indeed, the PTO has not established the “general conditions” that would lead one of ordinary skill in the art to the invention of Claim 31 because no cause-effect relationship has been established between any

recognized result and changing the optical transmissivity of the translucent covering layer to the range of 5 to 10%. Because the argument of finding optimum ranges through routine experimentation is inapplicable in this case and no other reasons has been provided for determining the claimed range for the optical transmissivity of the translucent covering layer, the PTO has failed to establish a prima facie case of obviousness.

Furthermore, it is noted that the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) has not removed the requirement that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Furthermore, MPEP 2143 suggests that all elements (when the references are combined) need to be known in the art to support a conclusion of obviousness. Because no prior art has been set forth teaching or suggesting the claimed range for the optical transmissivity of the translucent covering layer, Claim 31 is allowable over the prior art.

In view of the above, the lining element recited in independent Claim 31, considered as a whole, would not have been obvious in view of Misaras. The rejection of Claim 31 over Misaras under 35 U.S.C. § 103(a) is improper. Therefore, Claim 31 is patentable over Misaras.

Dependent Claims 32, 35-36, 38-43, 45, and 47, which depend from independent Claim 31, are also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 31-32, 35-36, 38-43, 45, and 47 under 35 U.S.C. § 103(a).

Rejection of Claim 37

On page 14 of the Office Action the Examiner rejected Claim 37 under 35 U.S.C. § 103(a) as being unpatentable over Misaras in view of Miller. Claim 37 depends from independent claim 31.

The Examiner acknowledged that Misaras does not disclose an elastomer having a hardness of approximately 40 Shore A.

The Examiner stated that Miller discloses:

“Preferably, body 16 of bulb holder 10 is injection molded with at least two stampings 46. Body 16 may be molded from a flexible polymeric material, preferably having a Shore A durometer hardness of between approximately 50 Shore A and 105 Shore A, more preferably between approximately 60 Shore A and 90 Shore A, and most preferably approximately 60 Shore A, such as a

thermoplastic elastomer (TPE) material, such as Kraton G7720B or the like. Alternatively, a plasticized poly vinyl chloride (PVC) material, a flexible urethane, a silicone or the like may be used, without affecting the scope of the present invention. By injection molding of body 16 with the stampings within the flexible material, the present invention assures a water-tight construction to substantially preclude water from entering the terminals 20 and 24 within body 16” [Column 5, Lines 29-44]. (paragraph 38 of the Office Action).

The Examiner concluded that:

It would have been obvious to...modify the lining element of Misaras, specifically the elastomer, to incorporate the Shore durability characteristics, as principally taught by Miller, so as to ensure appropriate hardness and flexibility of the elastomer. It has also been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233]. (paragraph 38 of the Office Action).

Misaras is directed to a backlighting method for an automotive trim vehicle.

Miller is directed to an illumination device for exterior mirror.

Claim 31 and its dependent claim 37 recites a “lining element” including, in combination with other elements, “a covering layer,” “wherein the covering layer is translucent, and wherein the translucent covering layer has an optical transmissivity in a visible spectral range of 5 to 10%.”

The “lining element” recited in independent Claim 31 would not have been obvious in view of Misaras, alone or in any proper combination with Miller, under 35 U.S.C. § 103(a). Misaras, alone or in any proper combination with Miller, does not disclose, teach or suggest a “lining element” wherein, in combination with other elements, “the translucent covering layer has an optical transmissivity in a visible spectral range of 5 to 10%.” To transform the backlighting method of Misaras and the illumination device of Miller into a “lining element” (as recited in Claim 31) would require still further modification, and such modification is taught only by the Applicant’s own disclosure.

The lining element recited in independent Claim 31, considered as a whole, would not have been obvious in view of Misaras and/or Miller. The rejection of claim 31 over Misaras in view of Miller under 35 U.S.C. § 103(a) is improper. Therefore, Claim 31 is patentable over Misaras in view of Miller.

Dependent Claim 37, which depends from independent Claim 31, is also patentable. See 35 U.S.C. § 112 ¶ 4.

The Applicant respectfully requests withdrawal of the rejection of Claims 37 under 35 U.S.C. § 103(a).\

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is believed that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

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FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (202) 672-5349
Facsimile: (202) 672-5399

By



Matthew J. Kremer
Attorney for Applicant
Registration No. 58,671